

Notice of Allowability

Application No.

10/617,685

Examiner

Kambiz Abdi

Applicant(s)

STEFIK ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7 December 2004.
2. ☒ The allowed claim(s) is/are 70,74,75,81-84,86-91,93,96,102-105 and 107-136.
3. ☒ The drawings filed on 14 July 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 4 November 2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

JAMES S. THIMMEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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DETAILED ACTION

1. Text of all the office actions previously forwarded to the applicant as well as all the responses to such office actions has been incorporated by reference.

- Claims 1-69, 71-73, 76-80, 85, 92, and 97-101 have been canceled.
- Claims 70, 74, 82-83, 86-91, 93, 96, 103,-104, 108-110, 115-19 have been amended.
- New Claims 120-136 have been added.
- Claims 70, 74-75, 81-84, 86-91, 93, 96, 102-105 and 107-136 have been allowed.

Examiner's Amendment

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

3. Authorization for this examiner's amendment was given in an interview with attorney Carlos R. Villamar and Bijan Tadayon conducted in person on 7 December 2004.

4. The examiner under agreement by the attorney representing the applicant has amended claims 70, 74, 82-83, 86-91, 93, 96, 103,-104, 108-110, 115-19. Also canceling claims 1-69, 71-73, 76-80, 85, 92, and 97-101.

The claims in the application has been amended as follow:

70. (Currently amended) A system for ~~associating~~ enforcing usage rights associated with digital content, said system comprising:

means for creating usage rights from a grammar, said usage rights specifying a manner of use indicating one or more stated purposes ~~for which~~ of how the digital content can be at least one of used and distributed by an authorized party;

means for associating the usage rights with the digital content;

means for exchanging information with a first non-centralized repository for storing the digital content and the associated usage rights and for processing a usage transaction specifying the usage rights to determine if access to the digital content can be granted; and

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means for exchanging information with a second non-centralized repository for generating the usage transaction specifying the usage rights for requesting access to the digital content,

wherein the usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised,

said means for creating comprises means for selecting one or more symbols from a first set of predetermined symbols to define a valid sequence of symbols to indicate the manner of use,

said means for creating comprises means for selecting one or more symbols from a second set of predetermined symbols to define a valid sequence of symbols to indicate the conditions,

the manner of use can be used to specify how an authorized user is able to render the digital content, how an authorized party can use the digital content to create a new digital content, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the corresponding digital content on a device on which the digital content is stored, and how an authorized party is able to delete the digital content from a device on which digital content is stored, and

the usage rights identify rendering devices upon which the digital content is authorized to be rendered.

71-73. (Cancelled)

74. (Currently amended) The system as recited in ~~claim 73~~ claim 70, wherein said means for creating comprises means for designating a set of default conditions.

75. (Previously Presented) The system as recited in claim 74, wherein said means for creating further comprises means for changing the default set of conditions.

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76-80. (Cancelled)

81. (Previously Presented) The system as recited in claim 70, wherein the digital content is a software program.

82. (Currently amended) The system as recited in claim 81, wherein the manner of use specifies ~~the manner by which~~ how an authorized party is able to install the software program.

83. (Currently amended) The system as recited in claim 81, wherein the manner of use specifies ~~the manner by which~~ how an authorized party is able to uninstall the software program.

84. (Previously Presented) The system as recited in claim 70, wherein the usage rights comprise a revenue identifier for identifying a revenue owner of the digital content.

85. (Cancelled)

86. (Currently amended) The system as recited in ~~claim 74~~ claim 70, wherein said means for creating comprises means for creating a first version of usage rights having a first set of conditions and means for creating a second version of usage rights having a second set of conditions.

87. (Currently amended) The system as recited in ~~claim 72~~ claim 70, wherein said means for creating comprises means for selecting one or more codes from a set of predetermined codes to define a valid sequence of codes to indicate the manner of use.

88. (Currently amended) The system as recited in ~~claim 72~~ claim 70, wherein said means for creating comprises means for selecting one or more identifiers from a set of predetermined identifiers to define a valid sequence of identifiers to indicate the manner of use.

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89. (Currently amended) The system as recited in ~~claim 72~~ claim 70, wherein said means for creating comprises means for selecting one or more parameters from a set of predetermined parameters to define a valid sequence of parameters to indicate the manner of use.

90. (Currently amended) The system as recited in ~~any one of claims 70-89~~ claim 70, wherein said means for creating and said means for designating, and said means for associating each comprise at least one of one or more computer devices and one or more computer readable executable instructions recorded on media.

91. (Currently amended) A method for ~~associating~~ enforcing usage rights associated with digital content, said method comprising:

electronically creating usage rights from a grammar, said usage rights specifying a manner of use indicating one or more purposes of plural purposes ~~for which~~ of how the digital content can be at least one of used and distributed by an authorized party;

associating the usage rights with a digital content;

exchanging information with a first non-centralized repository for storing the digital content and the associated usage rights and for processing a usage transaction specifying the usage rights to determine if access to the digital content can be granted; and

exchanging information with a second non-centralized repository for generating the usage transaction specifying the usage rights for requesting access to the digital content,

wherein the usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised,

said step of creating comprises selecting one or more symbols from a first set of predetermined symbols to define a valid sequence of symbols to indicate the manner of use,

said step of creating comprises selecting one or more symbols from a second set of predetermined symbols to define a valid sequence of symbols to indicate the conditions,

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the manner of can be used to specify how an authorized party is able to render the digital content, how an authorized party can use the digital content to create a new digital content, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the digital content on a device on which the digital content is stored, and how an authorized party is able to delete the digital content from a device on which the digital content is stored, and

the usage rights identify rendering devices upon which the digital content is authorized to be rendered.

92. (Cancelled)

93. (Currently amended) The method as recited in ~~claim 92~~ claim 91, wherein the conditions comprise a set of default conditions.

94-95. (Cancelled)

96. (Currently amended) The method as recited in ~~claim 92~~ claim 93, wherein said step of creating further comprises changing the default set of conditions.

97-101. (Cancelled)

102. (Previously Presented) The method as recited in claim 91, wherein the digital content is a software program.

103. (Currently amended) The method as recited in claim 102, wherein the manner of use specifies the manner by which an authorized party is able to install the software program.

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104. (Currently amended) The method as recited in claim 102, wherein the manner of use specifies the manner by which an authorized party is able to uninstall the software program.

105. (Previously Presented) The method as recited in claim 91, wherein the usage rights comprise a revenue identifier for identifying a revenue owner of the digital content.

106. (Cancelled)

107. (Previously Presented) The method as recited in claim 91, wherein said step of creating further comprises creating a first version of usage rights having a first set of conditions and a second version of usage rights having a second set of conditions.

108. (Currently amended) The method as recited in ~~claim 94~~ claim 91, wherein said step of creating comprises selecting one or more codes from a set of predetermined codes to define a valid sequence of codes to indicate the manner of use.

109. (Currently amended) The method as recited in ~~claim 94~~ claim 91, wherein said step of creating comprises selecting one or more identifiers from a set of predetermined identifiers to define a valid sequence of identifiers to indicate the manner of use.

110. (Currently amended) The method as recited in ~~claim 94~~ claim 91, wherein said step of creating comprises selecting one or more parameters from a set of predetermined parameters to define a valid sequence of parameters to indicate the manner of use.

111. (Previously Presented) The system as recited in claim 70, wherein said first repository and said second repository are parts of a same repository.

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112. (Previously Presented) The system as recited in claim 70, wherein said first repository and said second repository are parts of different repositories.

113. (Previously Presented) The method as recited in claim 91, wherein said first repository and said second repository are parts of a same repository.

114. (Previously Presented) The method as recited in claim 91, wherein said first repository and said second repository are parts of different repositories.

115. (Currently amended) A The system as recited in claim 70, wherein said content comprises a contents file and said usage rights comprise a description tree file.

116. (Currently amended) A The system as recited in claim 70, wherein said content and said usage rights are stored on the same device.

117. (Currently amended) A The system as recited in claim 70, wherein said content and said usage rights are stored on different devices.

118. (Currently amended) ~~A-system~~ The method as recited in claim 91, wherein said content and said usage rights are stored on the same device.

119. (Currently amended) ~~A-system~~ The method as recited in claim ~~447~~ 91, wherein said content and said usage rights are stored on ~~the same device~~ different devices.

120. (New) The system as recited in claim 70, wherein at least one of the conditions which must be satisfied before the manner of use may be exercised is possession of a digital ticket.

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121. (New) The system as claimed in claim 81, wherein the manner of use specifies how an authorized party is able to execute the software program.

122. (New) The method as recited in claim 91, wherein at least one of the conditions which must be satisfied before the manner of use may be exercised is possession of a digital ticket.

123. (New) The method as recited in claim 102, wherein the manner of use specifies how an authorized party is able to execute the software program.

124. (New) The system as recited in claim 70, wherein the usage rights are stored on an optical disk.

125. (New) The system as recited in claim 70, wherein the usage rights are stored on a removable storage device.

126. (New) The system as recited in claim 70, wherein the digital content is stored on an optical disk.

127. (New) The system as recited in claim 70, wherein the digital content is stored on a removable storage device.

128. (New) The method as recited in claim 91, wherein the usage rights are stored on an optical disk.

129. (New) The method as recited in claim 91, wherein the usage rights are stored on a removable storage device.

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130. (New) The method as recited in claim 91, wherein the digital content is stored on an optical disk.

131. (New) The method as recited in claim 91, wherein the digital content is stored on a removable storage device.

132. (New) The method as recited in claim 91, wherein the first and second set of predetermined symbols include one or more of the same symbols.

133. (New) The method as recited in claim 91, wherein the first and second set of predetermined symbols include one or more different symbols.

134. (New) The system as recited in claim 70, wherein the first and second set of predetermined symbols include one or more of the same symbols.

135. (New) The system as recited in claim 70, wherein the first and second set of predetermined symbols include one or more different symbols.

136. (New) A computer program product including one or more computer-readable instructions embedded in a computer-readable medium for causing one or more computer processors to perform the steps recited in claim 91.

Allowable Subject Matter

5. Claims 70, 74-75, 81-84, 86-91, 93, 96, 102-105 and 107-136 are allowed over the prior art of record.

6. The following is an examiner's statement of reason for allowance:

The closest prior art of record is U.S. Patent No. 5,260,999 to Robert M. Wyman et al., U.S. Patent No. 5,138,712 to John R. Corbin, U.S. Patent No. 5,255,106 to Peter D. Castro, and

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U.S. Patent No. 5,646,992 to Ronald J. Subler. Wyman provides a method and system to control usage policy of a digital product based on licensed terms, conditions, and authorization. Wyman is directed towards distribution of digital products and licensing the same either in full or in part. Wyman also discloses how a rights management system and method can add terms and condition to a licensed digital software, content, or data. Corbin discloses a method and system of creating a new version or upgrade to a digital work, as well as deleting the digital work from a system. Castro discloses how a digital work can be concealed, in addition Subler teaches the installing and uninstalling of software and digital works. Finally Johnson discloses a method and system to create multiple conditions of usage for different versions of the same digital works. The general states of all of the mentioned prior arts of records disclose method and system to track and bill usage of digital products. The closest foreign prior art of record is European Patent No. GB-2236604 A to John R Corbin, and the NPL cited by the applicant titled "Digital Rights Management Technology" by Weber, R. published in October 1995, which they relate to the general state of the art. On the other hand, applicants claimed invention is directed towards creating a usage rights composed of selecting one or more symbols from a first set of predetermined symbols to define a valid sequence of symbols to indicate the manner of use.

In regards to independent claims 70, 91, and 136 the closes prior art of record when taken either individually or in combination with other prior art of record fails to teach or suggest the step of controlling the manner of use of the digital work in accordance with the manner of use specified by said usage right if the requester possesses the digital rights, wherein;

said step of creating comprises selecting one or more symbols from a first set of predetermined symbols to define a valid sequence of symbols to indicate the manner of use,

said step of creating comprises selecting one or more symbols from a second set of predetermined symbols to define a valid sequence of symbols to indicate the conditions,

the manner of can be used to specify how an authorized party is able to render the digital content, how an authorized party can use the digital content to create a new digital content, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the digital content on a device on which the digital content is stored, and how

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an authorized party is able to delete the digital content from a device on which the digital content is stored, and
the usage rights identify rendering devices upon which the digital content is authorized to be rendered.

Claims 74-75, 81-84, 86-90 are dependent upon claim 70, claims 93, 96, 102-105 and 107-135 are dependent on independent claim 91, thus have all the limitations of independent claims 70 and 91 and are allowable for the same reason.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Kambiz Abdi
Examiner



January 6, 2005